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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215813
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark

Application Serial No. 85936327

Published in the Official Gazette

Opposition No. 91215813

**NAJAT KANACHE and  
CRYSTALLINE MANAGEMENT,  
LLC,**

**Opposers**

v.

**INTERNATIONAL PASTRY  
CONCEPTS LLC and  
DOMINIQUE ANSEL,**

**Applicants**

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**MEMORANDUM OF LAW IN SUPPORT OF APPLICANTS' MOTION TO  
DISMISS OPPOSERS' NOTICE OF OPPOSITION FOR FAILURE TO STATE A  
CLAIM FOR WHICH RELIEF MAY BE GRANTED PURSUANT TO FED. R. CIV. P.  
12(b)(6)**

The following is the Motion to Dismiss of Applicants International Pastry Concepts LLC and Dominique Ansel (collectively, "Applicants"), owner of Federal Trademark Application Serial No. 85936327 for the mark CRONUT, by and through Counsel, Candice S. Cook of The Cook Law Group, PLLC, to the Notice of Opposition filed on April 8, 2014 by Najat Kaanache and Crystalline Management, LLC (hereinafter "Opposers"). Applicants hereby submit their Motion to Dismiss for the United States Patent and Trademark's Office review.

International Pastry Concepts LLC and Dominique Ansel (“Applicants”) move to dismiss those claims of the Notice of Opposition (“Opposition”) that rely upon Sections 2(d) (“likelihood of confusion”); 2(e)(1) (“descriptiveness”); 2 1(a) (“lack of bona fide use in commerce”); and 29 (“fraud upon the United States Patent and Trademark Office”) of the Lanham Act (“Act”) on the grounds that Opposers Najat Kaanache (“Opposer Kaanache”) and Crystalline Management LLC (“Opposer CM”) or (collectively, “Opposers”) lack standing to bring the Notice of Opposition and, alternatively, the Opposition fails to state a claim upon which relief can be granted.

In addition, Applicants request that the Trademark Trial and Appeal Board (“Board” or “TTAB”) suspend its proceedings pending disposition of this motion.

## **I. Introduction**

The instant case involves specious claims by Opposers attempting to free-ride upon the fame and good name of Applicants. While Opposers claim to have first-used the mark CRONUT or CRONUTS, it is clear, from Opposers’ own evidence, that the word was not applied to the croissant-donut hybrid pastry that has taken the nation—and the world—by storm, and is intrinsically identified with inventor and producer Dominique Ansel and the New York City Dominique Ansel Bakery. Instead, Opposers first used the phrase to describe, in Opposer Kaanache’s own words, “MINI FUNKY croquetas,”<sup>1</sup> which were a savory ring-shaped crawfish croquette appetizer appearing for only a few short weeks at Texas restaurant Private Social (also

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<sup>1</sup> From Opposer Kaanache’s personal Twitter account. <https://twitter.com/najatkaanache/status/318844041502531584> (emphasis in original); see also a March 2013 TripAdvisor report describing the dish it as “crawfish donut-shaped croquettes” appetizer. [http://www.tripadvisor.com/ShowUserReviews-g55711-d2401781-r156068208-Private\\_Social-Dallas\\_Texas.html](http://www.tripadvisor.com/ShowUserReviews-g55711-d2401781-r156068208-Private_Social-Dallas_Texas.html).

called “P|S,”)<sup>2</sup> before being discontinued and later, no longer in the shape of ring, as a seafood patty at Texas restaurant Souk.<sup>3</sup>

Additionally, Opposer Kaanache, being a chef for hire at each of these restaurants, was not entitled to ownership or trademark registration of the protein-based appetizer nor does she adequately plead or prove prior use in her registration application. Opposer CM has failed to submit *any* evidence as to how it is involved in the Opposition.

What *is* evident, however, is that none of the incarnations that Opposers lay claim to could be mistaken for, or confused with, Applicants’ famous pastry brand nor would any qualify for trademark protection in Class 30. Further, there is no evidence to suggest that Opposer Kaanache was personally responsible for naming the “cronuts” dish.

Prior to Applicants’ documented first use of what is now known as the Cronut pastry, Opposer Kaanache simply served up crawfish “mini croquetas.”<sup>4</sup> It was not until *after* June 2013 that she introduced the phrase “creative donuts,” making it up completely out of whole cloth, after Applicants’ signature pastry became famous, and she was pressed to define what her “cronuts” meant. Unable to rely on previous definitions as they narrowed the dishes to savory appetizers having nothing to do with a sweet pastry, Kaanache became creative in her terminology. However, that creative attempt, like the savory dishes she once cooked up at Private Social and Souk, must fail. The Notice of Opposition is nothing more than a blatant attempt to free-ride upon Applicants’ fame and good will and must be denied by this Board.

## **II. Statement of Facts**

In 2006, Dominique Ansel (“Ansel”) came to the United States with only two suitcases and a dream to open his own bakery. After growing up poor in Beauvais, France, his career in the

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<sup>2</sup> *Id.*

<sup>3</sup> [http://blogs.dallasobserver.com/cityofate/2013/11/your\\_first\\_look\\_at\\_souk\\_in\\_tri.php](http://blogs.dallasobserver.com/cityofate/2013/11/your_first_look_at_souk_in_tri.php).

<sup>4</sup> *See supra*, fn. 1.

pastry world began at the age of 16 washing dishes and sweeping floors in a restaurant. Due to hard work, determination and a talent for developing outstanding pastries, he climbed the ranks of famed Parisian pastry institution, “Fauchon,” where he worked for seven years, eventually becoming their corporate pastry chef. In 2006, renowned chef Daniel Boulud invited Ansel to be the Executive Pastry Chef for his New York Restaurant “Daniel.”<sup>5</sup> At Daniel, Ansel continued to hone his skills and was part of the team that led the restaurant to receive its first four-star *New York Times* rating, three Michelin stars and the prestigious James Beard award for Outstanding Restaurant of the Year.<sup>6</sup> In 2010, Ansel was also named one of the Top 10 Pastry Chefs in the U.S. by *Dessert Professional* magazine.<sup>7</sup>

In 2011, his dream was realized when he opened the Dominique Ansel Bakery (“Ansel Bakery”) in New York. From the very beginning, the bakery was a success, drawing rave reviews and lines of customers.<sup>8</sup> Within the first four months of opening, the bakery was awarded both *Time Out New York* and *Metromix’s* “Best New Bakery of 2012.”<sup>9</sup> In 2013, Ansel was one of just four finalists for the James Beard award for “Outstanding Pastry Chef,” the culinary equivalent of the Academy Awards.<sup>10</sup>

Believing that creativity and innovation keeps customers happy, Ansel introduces new items to his menu every six to eight weeks. The subject of the instant Opposition, the Cronut pastry, was introduced on May 10, 2013, after Ansel spent several months and tested more than ten recipes to perfect his creation.<sup>11</sup> The Cronut pastry’s popularity was immediate, sparking long

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<sup>5</sup> <http://www.businessweek.com/articles/2014-05-06/dominique-ansel-winner-of-james-beard-award-for-his-cronut-keeps-the-prized-pastry-scarce-so-he-can-create-new-things>.

<sup>6</sup> <http://www.newyork.com/articles/restaurants/dominique-ansel-outstanding-pastry-chef-james-beard-2013-nominee-47278>.

<sup>7</sup> *Id.*

<sup>8</sup> <http://firstwefeast.com/eat/the-9-dishes-that-made-my-career-dominique-ansel/>.

<sup>9</sup> <http://www.timeout.com/newyork/restaurants/best-new-bakery-dominique-ansel-bakery-bakeries>.

<sup>10</sup> <http://greatideas.people.com/2014/05/06/james-beard-award-winners-2014>.

<sup>11</sup> [http://www.crainsnewyork.com/article/20130605/HOSPITALITY\\_\\_TOURISM/130609939/the-man-behind-the-cronut-craze#](http://www.crainsnewyork.com/article/20130605/HOSPITALITY__TOURISM/130609939/the-man-behind-the-cronut-craze#).

lines hours before the bakery opened, becoming an “international craze,”<sup>12</sup> and being dubbed, “the world’s most famous pastry.”<sup>13</sup> As copycats quickly emerged,<sup>14</sup> Applicants applied for trademark protection in Class 30 on May 19, 2013, citing a widely-documented date of first use of May 10, 2013.<sup>15</sup> Receipts and packaging show that the Cronut brand applies to all creations at the Ansel Bakery, which has become known as the “birthplace of the Cronut” pastry.<sup>16</sup> Ansel continued to receive accolades such as *Crain’s* “40 under 40,” and *Business Insider’s* “Most Innovative People of 2013.”<sup>17</sup> In May of 2014, Ansel took home the coveted James Beard Award, with *People* magazine calling him the “Cronut mastermind” and noting that “his prowess with dessert is more than just hype.”<sup>18</sup> Most importantly, the media coverage is proof that in a relatively short period of time, the Cronut brand and pastry has acquired distinctiveness under the secondary meaning doctrine as the goods are intrinsically connected, in the minds of consumers and the food trade, with Dominique Ansel and the Ansel Bakery.

Opposer Najat Kaanache also came to the United States to work as a chef, but the similarities with Ansel end there. Kaanache’s resume consists of being an actress and a stagiere, or “unpaid intern” in several famous restaurants.<sup>19</sup> Her first claim to “cronuts” begins at Dallas restaurant, “Private Social.” In her one-star review of the restaurant, food critic Leslie Brenner

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<sup>12</sup> <http://www.usatoday.com/experience/food-and-wine/photo-gallery/chef-dominique-ansels-cronut-creation-has-sparked-a-craze/7700671/>.

<sup>13</sup> <http://www.dailymail.co.uk/femail/article-2624765/Happy-birthday-Cronut-Chef-Dominique-Ansels-world-famous-pastry-celebrates-anniversary.html>.

<sup>14</sup> See e.g., <http://eater.com/archives/2013/06/18/eight-more-cronut-copycats-from-around-the-world.php>.

<sup>15</sup> <http://www.grubstreet.com/2014/05/cronut-1-year-anniversary.html>.

<sup>16</sup> <http://www.grubstreet.com/2014/05/cronut-1-year-anniversary.html>.

<sup>17</sup> <http://mycrains.crainsnewyork.com/40under40/>; <http://www.businessinsider.com/most-innovative-people-under-40-2013-10>.

<sup>18</sup> <http://greatideas.people.com/2014/05/06/james-beard-award-winners-2014/>.

<sup>19</sup> <http://www.dallasnews.com/entertainment/columnists/leslie-brenner/20130304-critics-notebook-leslie-brenners-first-look-at-two-dallas-restaurants-where-new-chefs-are-strutting-their-stuff.ece>; See also <http://www.dallasnews.com/entertainment/restaurants/restaurant-reviews/20130424-restaurant-review-at-ps-modernist-high-jinks-belly-flop-meat-and-potatoes-almost-save-the-day.ece>.

<sup>20</sup> *Id.*

<sup>21</sup> <http://dallas.eater.com/archives/2013/05/24/heres-private-socials-new-awesome-texas-food-menu.php>.

described the dish, as among other things, “crawfish-flavored.”<sup>20</sup> This is not only **not** Applicants’ famous Cronut pastry, but would not qualify for trademark protection in Class 30, as crawfish croquettes belong in Class 29. Further, Kaanache would not qualify for ownership of the dish since she was merely a chef for hire and has shown no proof that she was the originator of the name or holds any intellectual property rights to it.

In May of 2013, while Applicants were applying for trademark protection for the Cronut pastry, Private Social was introducing a new “Awesome Texas Food” themed menu, absent any trace of crawfish croquette cronuts.<sup>21</sup> However, in June 2013, after Applicants’ Cronut pastry rocketed to fame, Kaanache declared that she would now be serving her never-before-seen-or-heard-of “sweet version” of cronuts. The debut was short-lived as Private Social closed in July of 2013.<sup>22</sup>

Months later Kaanache resurfaced at Moroccan restaurant, Souk, where she again offered crawfish croquettes. The *Dallas Observer* stated that they were “inspired by Spanish croquetas made with shellfish or cod.”<sup>23</sup> The appetizer was no longer ring-shaped,<sup>24</sup> but rather just round patties. Once again food critic Brenner weighed in:

“I was surprised to see crawfish ‘cronuts,’ an appetizer Kaanache served at [Private Social], on the menu. Crawfish strike me as keenly un-Moroccan, but somehow they work better here than they did at the modernist place. These have nothing to do with the cronuts people went crazy for in New York (croissant-type laminated pastry treated like donuts). Rather, these are savory, crisply fried crawfish fritters, served with a yogurt dipping sauce touched with za’atar and

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<sup>22</sup> <http://eatsblog.dallasnews.com/2013/07/ps-the-restaurant-formerly-known-as-private-social-has-closed.html>.

<sup>23</sup> [http://blogs.dallasobserver.com/cityofate/2013/11/your\\_first\\_look\\_at\\_souk\\_in\\_tri.php](http://blogs.dallasobserver.com/cityofate/2013/11/your_first_look_at_souk_in_tri.php)

<sup>24</sup> [http://blogs.dallasobserver.com/cityofate/2013/05/private\\_socials.php](http://blogs.dallasobserver.com/cityofate/2013/05/private_socials.php).

other spices.”<sup>25</sup> Brenner also took note of the dessert “cronuts,” describing them as, “the type that [Applicants] made famous in New York, but [Kaanache’s] were clunky and hard... No amount of gels, foams, powders, or flower petals could save them.”<sup>26</sup>

As Brenner stated, the Cronut pastry is intrinsically connected with Applicants, yet despite this connection, and without citing a date of first use, Opposers filed for a trademark for cronuts on June 13, 2013. In July 2013, Opposers also filed for trademark protection in Classes 9, 16 and 40 based on “intent to use.” In February of 2014, Kaanache left her post at Souk.<sup>27</sup>

Falsely maintaining that she is the inventor of the Cronut pastry and using the “TM” symbol on her website, Kaanache now insists that the word “cronuts” is a combination of the words, “creative doughnuts.” To make this point, her latest iteration is an unabashed copy of Applicants’ look and design which was never offered by Kaanache prior to the fame of Applicants’ Cronut pastry.

Once again, Brenner weighed in as the eye witness to the evolution of Kaanache’s supposed “cronuts.” Taking Kaanache to task for her insistence that she had cronuts on her menu as far back as February 2013, Brenner writes,

Well, I’m here to tell you that I sampled chef Kaanache’s cronuts [...] back in February — and yes, they were called cronuts on the menu [...] I did discuss the appetizer, which I tasted on three occasions. That’s why **I can tell you with absolute certainty that Kaanache’s cronuts have nothing to do with the cronuts that are making such a huge splash nationally.** Kaanache’s cronuts were not made from laminated dough, as croissants are (it’s the layers of butter in the dough that gives croissants and, it seems, cronuts their flakiness) ...One time they were crawfish-flavored.... Every time I sampled them, they were served hanging from a wire on a banana-ripening hook. These swinging fritters have little resemblance to Ansel’s cronuts,...”<sup>28</sup>

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<sup>25</sup> <http://www.dallasnews.com/entertainment/restaurants/headlines/20140212-restaurant-review-moroccan-cooking-with-a-sweet-tooth-at-souk.ece>.

<sup>26</sup> <http://www.dallasnews.com/entertainment/restaurants/headlines/20140212-restaurant-review-moroccan-cooking-with-a-sweet-tooth-at-souk.ece>.

<sup>27</sup> <http://sidedish.dmagazine.com/2014/02/24/najat-kaanache-is-out-of-the-kitchen-at-souk-in-trinity-groves>.

<sup>28</sup> <http://eatsblog.dallasnews.com/2013/06/letting-the-air-out-of-najat-kaanaches-cronut-scandal.html/> (emphasis added).



Even though Kaanache's misrepresentations have not gone unnoticed by the press and the public, she spent a year finding ways to capitalize on the innovation, fame, popularity and success of the Applicants' Cronut pastry. Her failed attempts have continued, unabated, until finding their way into this baseless Notice of Opposition as another platform for her empty assertions. The Lanham Act expressly prohibits such shameless, free-riding, bad faith attempts and this conduct should not be rewarded. Further, the record is clear that Applicants are the producers of the Cronut pastry brand and Opposers have no standing or claims under the Act.

### III. Legal Argument

#### A. Legal Standard for a Motion to Dismiss Under Rule 12(b)(6)

In considering a motion for relief under Federal Rule of Civil Procedure ("Rule") 12(b)(6), the Court must accept as true all well-pleaded factual allegations and draw all reasonable inferences in favor of the Plaintiff.<sup>29</sup> The Rule requires that a Plaintiff plead "enough facts to state a claim to relief that is plausible on its face."<sup>30</sup> In analyzing the plausibility standard, it is not a "probability requirement," and must state enough facts to be plausible.<sup>31</sup> Where a complaint

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<sup>29</sup> *Blue Tree Hotels Ltd. v. Starwood Hotels & Resorts Worldwide, Inc.*, 369 F.3d 212, 217 (2d Cir. 2004); see also *DeJesus et al. v. Sears, Roebuck & Co.*, 87 F.3d 65, 69 (2d Cir. 1996).

<sup>30</sup> *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007) ("A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.")

<sup>31</sup> *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (clarifying that the pleading standard set forth in *Twombly* applies to all civil cases. Now, a complaint must state enough facts to make a claim plausible.

<sup>32</sup> *DeJesus, et al. v. Sears, Roebuck & Co.*, 87 F.3d 65, 69 (2d Cir. 1996)(citations and internal quotation marks omitted.)

<sup>33</sup> *Twombly*, 550 U.S. at 544; *Telenor East Invest AS v. Altimo Holdings & Invest Ltd.*, No. 07 Civ. 4829(DC), 2008 WL 782733, at \*6 (S.D.N.Y. Mar. 25, 2008) (Chin, J). (citations and internal quotation marks omitted); See also *First Nationwide Bank v. Gelt Funding Corp.*, 27 F.3d 763, 771 (2d Cir. 1994) ("conclusions of law or unwarranted deductions of fact are not admitted") (citation omitted.)

<sup>34</sup> *Id.*

<sup>35</sup> *Twombly* instructs the court to disregard conclusions couched as factual allegations.

<sup>36</sup> *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 184, 189 (CCPA 1982); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490; 2 USPQ2d 2021 (Fed. Cir. 1987).

pleads facts “merely consistent with” a defendant’s liability, it “stops short of the line between possibility and plausibility of entitlement to relief.”<sup>32</sup>

A Rule 12(b)(6) motion “is designed to test the legal sufficiency of the complaint.”<sup>33</sup> Therefore, “[b]ald contentions, unsupported characterizations, and legal conclusions are not well-pleaded allegations and will not defeat “a motion to dismiss.”<sup>34</sup> Opposers simply plead “labels and conclusions” which are insufficient to defeat a Rule 12(b)(6) motion.<sup>35</sup> Thus, the Notice of Opposition should be dismissed with prejudice.

### **B. Opposers Lack Standing To Bring A Notice of Opposition**

The first requirement in filing an Opposition to a Trademark Registration is that the party has standing—which is a viable interest in the cancellation of the mark. The purpose of the standing requirement is to prevent litigation where there is no real controversy between the parties or where a plaintiff, petitioner, or opposer is no more than an intermeddler.<sup>36</sup> Opposer has the burden to demonstrate both standing and a ground upon which relief may be granted.<sup>37</sup> In the instant case, Opposers demonstrate neither.

In the case of a Notice of Opposition, the standing requirement has its basis in Section 13 of the Trademark Act which provides that, “[a]ny person who believes he would be damaged by the registration of a mark on the principal register, ... may . . . file an Opposition in the [USPTO] stating the grounds therefore...” An Opposer must also satisfy two judicially created

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<sup>37</sup> *Sterling Jewelers Inc. v. Romance & Co., Inc.*, Opposition No. 91207312 (TTAB March 27, 2014), (Board addressed the evidentiary requirements for making a registration properly of record under the governing Trademark Rules and for obtaining a dismissal for failure to prosecute).

requirements to have standing: 1) a “real interest” in the proceedings, and 2) a reasonable belief of damage.<sup>38</sup>

The term “damage,” as used in the Trademark Act § 13 and Trademark Act § 14, 15 U.S.C. § 1063 and 15 U.S.C. § 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively.<sup>39</sup> The “belief of damage” language in Section 13 has been interpreted to mean more than a subjective belief, and courts have held that the reasonableness of the belief could be demonstrated in various manners. As a threshold matter, the Board will analyze whether the Opposer has sufficiently pleaded standing to bring the instant Opposition. Here, neither party has pleaded nor proved standing to bring the instant Opposition.

In *Sterling Jewelers v. Romance & Co.*,<sup>40</sup> the Board dismissed the case for failure to prosecute, saying Sterling had failed to abide by the “simple and clear” precedent for what kind of registration evidence or testimony supporting the control of the mark a TTAB plaintiff needs to show. Here, as in *Sterling*, neither Opposer has submitted *any* evidence to show real interest and/or damage.

Opposer CM demonstrates no real interest in the proceeding, no reasonable belief in damages, nor is it clear as to what it is or does. Records indicate that Crystalline Management LLC is located in a four-bedroom home at 335 Peluxy Drive, Irving Texas 75089 owned by Charles Accivatti (“Accivatti.”) It is unclear as to Accivatti’s connection to the instant case. The Opposition fails to show or to prove that Opposer CM is, in any way, damaged by Applicants’ mark nor can it make any claim in the Notice of Opposition. Opposer CM lacks the requisite standing.

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<sup>38</sup> *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

<sup>39</sup> *Id.* (construing standing requirements of Trademark Act § 13, 15 U.S.C. § 1063 regarding oppositions and Trademark Act § 14, 15 U.S.C. § 1064 regarding cancellations consistently).

<sup>40</sup> Opposition No. 91207312 (March 27, 2014) [precedential].

To plead a “real interest,” Opposer must allege a “direct and personal stake” in the outcome of the proceeding. The allegations in support of Opposer’s belief of damage must have a reasonable basis “in fact.”<sup>41</sup> Opposer Kaanache also fails to allege facts sufficient to show a “real interest” in the proceeding, or a “reasonable basis” to support claims of damage.

Opposers filed a registration application *after* the date of Applicants and fail to cite first use, as required by law. Anecdotal evidence suggests that while working as a chef for hire, Kaanache prepared a savory appetizer that contained the word “cronuts” to suggest “crawfish croquettes,” which is an item that does not belong in Class 30. There is no evidence that Kaanache coined the menu item name, and for all intents and purposes, if there were any claims to be made, they would need to be made by her employer Private Social / P|S, which has closed.

Opposers confusingly filed an “intent to use” application at a later date than Applicants while simultaneously stating first use. Applicants are rightly known as the producers of the Cronut brand, and, as such, received protection in Class 30. Thus, the Board should rule in Applicants’ favor and dismiss the opposition with prejudice for lack of standing.

### **C. Opposers Have Failed To Allege Existence of A Cognizable and Protectable Trademark Right Under The Lanham Act**

Even if Opposers were found to have standing, their claims are wholly without merit. They merely parrot the text of the Lanham Act while providing only broad-based allegations and conclusions. Opposers offer up four counts to support their Opposition: 1) Likelihood of Confusion; 2) Descriptiveness; 3) Lack of Bona Fide Use in Commerce; and 4) Fraud Upon the USPTO. However, Opposers fail to provide more than broad-based allegations and conclusions without any basis in fact. Opposers fail to state any claims for which relief can be granted and these Claims should be dismissed.

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<sup>41</sup> See Trademark Trial and Appeal Board Manual of Procedure, (TBMP) 303.03(b) Standing for case definitions of “real interest,” “direct and personal stake,” “reasonable basis,” and “in fact.”

**D. Opposers Fail To State Any Claim Under Section 2(d) of the Lanham Act For Which Relief Can Be Granted**

Opposers cite Section 2(d) of the Lanham Act which prohibits, “[A] mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...,” yet confine their evidence of “likelihood of confusion” to three conclusory points.

In their first point, Opposers contend they are “Users of the CRONUTS mark for sweet and savory donuts with rights prior to any claims Opposers may use in designation CRONUT.” This claim is unintelligible, failing to make any sense to which a response can be formulated. However, in the event Count I, Claim 1 attempts to assert that *Opposers* had first use prior to *Applicants*, this is an equally unintelligible, unsubstantiated argument without evidentiary support.

The Lanham Act is designed to give protection to legitimate registered first users of a mark and also provides clear distinctions between products in one class versus another. Assuming that Opposers rely upon their “crawfish croquettes” to cite first use of the word, “cronuts,” this use was intended to describe a savory protein appetizer which would not be afforded protection in Class 30. Applicants’ pastry qualifies for Class 30, thus making them senior users and rightful owners of the Cronut mark.

Opposers’ Claim I, Count 2 contends that, “Prospective and actual customers familiar with Opposers and their CRONUTS goods will likely be mistaken or deceived as to the source, origin, affiliation, connection or association of Applicants’ goods, or suffer reverse confusion, mistake or deception that Opposers are junior users of their CRONUTS mark.” Opposers’ claim fails under the test for likelihood of confusion as determined by factors established in *Polaroid Corp. v. Polarad Elec. Corp.*: In deciding whether consumer confusion is likely, a court applies the factors first namely: (1) strength of the mark; (2) degree of similarity between the marks; (3)

competitive proximity of the parties' products in the marketplace; (4) likelihood that the plaintiff will "bridge the gap" between the products; (5) evidence of actual consumer confusion; (6) whether the defendant acted with bad faith; (7) the quality of defendant's product; and (8) consumer sophistication.<sup>42</sup>

The *Polaroid* test "is not a mechanical process where the party with the greatest number of factors weighing in its favor wins. Rather, the ultimate question is whether consumers are likely to be confused."<sup>43</sup> Determination of likelihood of confusion does not require examination and findings for each *Polaroid* factor. Different factors may play dominant roles depending on the evidence. Under the *Polaroid* factors, there is no evidence of confusion with Opposers' supposed mark. Instead, Applicants' mark is strong and has acquired secondary meaning while Opposers are acting in bad faith. Applicants discuss the "likelihood of confusion" test under the *Polaroid* factors.

**a) Applicants' Mark Is Strong and Has Achieved Secondary Meaning**

The Lanham Act is designed to protect the rights of the first user of a trademark **"particularly where that mark is a strong one."**<sup>44</sup> The Lanham Act was intended to "make actionable the deceptive and misleading use of marks" and to "protect persons engaged in ...commerce against unfair competition."<sup>45</sup> Section 43(a) of the Lanham Act is designed to "eliminate the confusion that is created in the marketplace by the sale of products [or services] bearing highly similar marks."<sup>46</sup>

A trademark is considered strong based on several tests. One test includes the reputation of the product identified by the trademark. A mark is "valid" and entitled to protection when it is

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<sup>42</sup> *Polaroid v. Polaroid Elec. Corp.*, 298 F.2d 492, 495 (2d Cir. 1961); see also *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402, 411 (S.D.N.Y. 2006).

<sup>43</sup> *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46 (2d Cir. 2000).

<sup>44</sup> *Streetwise v. Van Dam*, 159 F. 3d 739(2d Cir. 1998) (emphasis added).

<sup>45</sup> 45, 15 U.S.C. Section 1127. Section 43(a).

<sup>46</sup> *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 539 (2d Cir. 2005).

“distinctive” and links a product to its particular source.<sup>47</sup> Here, the Cronut brand is undeniably linked to Applicants as the source of the product. Before Applicants created their unique pastry brand, the word, “Cronut” had no inherent meaning. Much like famous trademarks Croissan’wich and Clamato,<sup>48</sup> the Cronut mark is suggestive of what it relates to, but the meaning cannot be discerned without it first being defined. In almost all cases where it is mentioned, the Cronut mark was first explained and defined for readers, which would not be necessary if it were descriptive.

However, even if descriptive, an exception can be found when a mark has “become distinctive of the applicant’s goods in commerce.”<sup>49</sup> A term which is descriptive may, through usage by one producer with reference to his product, acquire a special significance so that the consuming public can identify the producer of the goods.<sup>50</sup> This is what is known as the secondary meaning doctrine where the mark comes to identify not only the goods but the *source* of those goods. To establish secondary meaning, it must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer.<sup>51</sup>

Acquired distinctiveness is a question of fact and the Applicant may present evidence to establish that a mark has acquired distinctiveness. Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used.<sup>52</sup> The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered.<sup>53</sup>

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<sup>47</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 758 (1992).

<sup>48</sup> Owned by Burger King and Mott, respectively.

<sup>49</sup> *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

<sup>50</sup> 1 Nims, *Unfair Competition and Trademarks* at §37 (1947).

<sup>51</sup> 15 U.S.C. 1052(f).

<sup>52</sup> See *Ex parte Fox River Paper Corp.*, 99 USPQ 173, 174 (Comm’r Pats. 1953).

<sup>53</sup> See *Roux Labs. Inc., v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 72 (TTAB 1985).

When registration is sought of a mark that has become distinctive within the trade, public or both, evidence may be accepted as *prima facie* evidence of distinctiveness. To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product is to identify the source of the product rather than the product itself.<sup>54</sup>

The central matter in trademark protection is not to extend protection to a supplier of goods, but rather to protect consumers from unfair confusion.<sup>55</sup> Therefore, a crucial issue is whether ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”<sup>56</sup> Here, Applicants are undeniably considered the source of the Cronut pastry and brand and consumers would be misled if Opposers were granted ownership of the mark.

Prior to Applicants coining the name “Cronut” to brand a unique hybrid pastry in May of 2013, the word “Cronut” had no real meaning.<sup>57</sup> However, once it was coined, the popularity of the Cronut pastry garnered an incredible following with long lines forming outside of the bakery, hours before opening, even during a blizzard.<sup>58</sup> The Wall Street Journal named the Cronut pastry as one of the “Words that Popped in 2013,” writing:

Food-savvy New Yorkers, meanwhile, might remember 2013 as the year the “cronut” was introduced to the world. The croissant-doughnut hybrid from Dominique Ansel’s Soho bakery quickly became a must-have confection. Many sought to imitate its success, but since Ansel trademarked “cronut,” the copycats had to come up with new names such as “dossant.”<sup>59</sup>

HGTV referred to Applicant Ansel as the “genius behind the Cronut,” and describes the pastry as “a beautiful cross between a warm, flaky croissant and a soft, sweet doughnut. The

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<sup>54</sup> *Inwood Labs. Inc. v. Ivs Labs Inc.*, 456 U.S. 844 (1982).

<sup>55</sup> *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 538-39 (2d Cir. 2003)

<sup>56</sup> *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 114 (2d Cir. 1009) (quoting *Saving Corp. v. Saving Grp.*, 391 F.3d 439, 456 (2d Cir. 2004)).

<sup>57</sup> The word varied from describing a Croatian poker site to an automatic machine that cracks nuts [www.cronuts.com](http://www.cronuts.com) (for poker); [http://www.youtube.com/watch?v=zrl1q\\_e7mcc](http://www.youtube.com/watch?v=zrl1q_e7mcc) (for the machine.)

<sup>58</sup> <http://www.thebraiser.com/cronut-line-in-blizzard-2014>.

<sup>59</sup> <http://online.wsj.com/news/articles/SB10001424052702304020704579278490453018658>.



Cronut™ process takes three days to perfect. Once the dough is proofed and fried in grapeseed oil, it's then rolled in sugar, filled with cream and topped with a glaze.” Expressly citing Ansel as the creator and producer, the Cronut pastry has been hailed as one of *Time* Magazine’s 25 Best Inventions of 2013.<sup>60</sup> The Cronut pastry has received its own Foursquare location on Spring Street in New York City, and the brand has exhibited such value that in one charity event for City Harvest, a dozen of Applicants’ Cronut pastries were auctioned for \$14K.<sup>61</sup>

A licensing agent, writing for *Forbes* magazine, remarks positively with regard to Applicants’ branding:

“If you’re reading the news, it may appear as though Cronuts have taken the country by storm. ... In case you don’t know, a Cronut is a cross between a doughnut and a croissant. Think of circled layers of croissant (with a hole in the middle) with the outside texture and cream or glaze of a doughnut. Dominique Ansel Bakery introduced the Cronut in May 2013...It’s not every day that a Cronut-like niche in the market is discovered, so I give a lot of credit to Ansel for his ingenuity, but more importantly, his intuition for taking the necessary steps to protect the name by registering the trademark, thereby positioning it to become a brand.”<sup>62</sup>

Applicants have been expressly mentioned, in numerous media outlets, as the source and producer of the Cronut pastry and brand. *Vogue* magazine and the *Financial Times* have each compared the Cronut brand to the Birkin, one of the most coveted handbag brands.<sup>63</sup> Even kids have chimed in on the Cronut craze, as Applicant Ansel and the Cronut pastry have appeared in a children’s culinary activity book.<sup>64</sup>

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<sup>60</sup> <http://techland.time.com/2013/11/14/the-25-best-inventions-of-the-year-2013/slide/the-cronut>.

<sup>61</sup> <http://eater.com/archives/2013/10/23/dozen-cronuts-sell-for-14k-roy-choi-on-dream-school.php>.

<sup>62</sup> <http://www.forbes.com/sites/michaelstone/2013/08/16/in-a-cronut-obsessed-world-twinkies-make-an-impressive-comeback>.

<sup>63</sup> <http://www.vogue.com/culture/article/cronut-creator-dominique-ansels-guide-to-obsession-worthy-parisian-treats/#1>.

<sup>64</sup> Mack, Andre Hueston, *Small Thyme Cooks: Culinary Coloring and Activity Book*, Get Fraiche Cru; Vol. 1 edition (May 1, 2014).

Applicant Ansel, inextricably connected to the Cronut brand, has been a guest on late-night television where Jimmy Fallon urged the audience and viewers to try the Cronut pastry.<sup>65</sup> Scores of celebrities have confessed their love of the Cronut pastry including Hugh Jackman, Martha Stewart, and QuestLove.<sup>66</sup> The Cronut pastry has become such a part of pop culture that it was even written into an entire episode of CBS series, *Two Broke Girls*, called, “And the Cronuts,” where the characters pointed to one specific bakery in New York that sells the croissant doughnut hybrid and garners long lines.<sup>67</sup> The episode was *not* about a Dallas-based restaurant serving up crawfish croquettes.

In stark contrast to the media attention that Applicants have received, critics and consumers alike have taken Opposers to task for using the word “cronuts” to describe any of their products. As one Texas writer pointed out, “Crawfish-flavored doth not a cronut make!” The writer dismissed Opposers’ claims entirely by ending the article with, “Let’s never talk about this again, OK?”<sup>68</sup>

Protection of the consumer is the primary objective of the Lanham Act<sup>69</sup> and, here, consumers are protected by Applicants’ mark as it is undeniable that the trade and public are aware of, and rely upon, Applicants, and not Opposers, to deliver the Cronut pastry and brand. Further, it is preposterous to suggest that customers would line the block at 5 a.m. to buy the Cronut pastry and be disappointed that they were not served a crawfish appetizer in the shape of a donut or any other of Kaanache’s iterations, including her weak imitation of Applicants’ award-winning pastry.

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<sup>65</sup> <http://www.grubstreet.com/2013/08/dominique-ansel-cronuts-how-to-make.html>.

<sup>66</sup> <http://firstwefeast.com/eat/dominique-ansel-cronut-stories-2013/>.

<sup>67</sup> “And the Cronuts.” Season 3, Episode 5. The show, set in New York, revolves around the two main characters losing business to the Cronut pastry.

<sup>68</sup> [http://austiniist.com/2013/06/10cronuts\\_are\\_a\\_Texas\\_creation.php](http://austiniist.com/2013/06/10cronuts_are_a_Texas_creation.php).

<sup>69</sup> *Id.*

**b) The Notice of Opposition is Filed in Bad Faith**

Under the *Polaroid* factors, “[b]ad faith generally refers to an attempt by a junior user of a mark to exploit the good will and reputation of a senior user by adopting the mark with the intent to sow confusion between the two companies’ products.”<sup>70</sup> This factor decides whether Opposers purposely adopted their mark to capitalize on Applicants’ reputation and goodwill and any confusion between the two products. In *George Basch Co. v. Blue Coral, Inc.*, the court stated, “There is an essential distinction [. . .] between a deliberate attempt to deceive and a deliberate attempt to compete. Absent confusion, imitation of certain successful features in another’s product is not unlawful and to that extent a ‘free ride’ is permitted.”<sup>71</sup>

Depending upon the circumstances, consumer confusion might as easily result from an innocent competitor who inadvertently crosses the line between a “free ride” and liability, as it could from intentionally fraudulent conduct. The *Basch* court found that Blue Coral’s acts were unintentional and not done wantonly, maliciously or with reckless disregard of Basch’s rights.”<sup>72</sup> Unlike Blue Coral, Opposers are not inadvertent line crossers. Instead, they purposefully and willfully attempt to deceive consumers as to the source of the product by insisting they coined “cronuts” as a combination of “creative donuts” though there is no evidence to support that claim prior to Applicants’ first use of the word to describe the Cronut pastry in May of 2013.

Although Opposers fail to submit *any* evidence illustrating their use of the word CRONUT OR CRONUTS in the Notice of Opposition, Opposers did submit in a separate USPTO application—surrounding the word CRONUTS—a March 2013 Private Social menu as evidence of their use of the word, “cronuts”. This evidence, however, does not support their bogus claims as the “mini-cronuts” listed are not given a description, appear not as dessert, but as

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<sup>70</sup> See *Star. Indus, Inc. v. Bacardi & Co. Ltd*, 412 F.3d 373, 381 (2d Cir. 2005).

<sup>71</sup> *Basch*, 968 F.2d at 1540 (quoting *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572 (2d Cir.1960) (citation omitted)).

<sup>72</sup> *Id.*

appetizers, and were served with truffle and squash, ingredients that belong in Class 29. Further, Opposers did not own Private Social and can lay no claim to any item that appeared on the menu.

Opposers also attach an article from *Sidedish*, where Kaanache "claims to have invented the cronut." However, one commentator of the article notes, "The item on the menu is not a dessert but a savory crawfish croquette. Not the same item. Only the name is the same. Do not know why she is claiming to have made the dessert."<sup>73</sup> It is unclear as to why Opposer has submitted this article as evidence since it only reflects her bald assertions, which the author of the article does not accept, and neither will the buying public, since the Cronut pastry is intrinsically linked with the Dominique Ansel Bakery.

Opposers also submit an October 2013 menu from Souk, long after Applicants' first use date of May 10, 2013.<sup>74</sup> Again, it is unclear why Opposers have submitted this since it simply supports Applicants' registration and claims to first use. While there is evidence that Opposer Kaanache used the word to describe an appetizer in two different restaurants where she worked as a chef, it is of no evidentiary importance here since the appetizer would not qualify for Class 30, nor does the Opposer have any rights to the appetizer. Further, Opposers never filed a date of first use in the application of June 17, 2013 which was after Applicants' May 19, 2013 application and first use date of May 10, 2013. As stated above, Opposers had no rights prior to May 19, 2013 to use the Cronut mark and this Notice of Opposition is filed in bad faith.

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<sup>73</sup> See Opposers' Exhibit 1 to its Notice of Opposition.

<sup>74</sup> Opposers' failed to include *any* evidence illustrating its "cronuts" menu with this Notice of Opposition. However, a copy of the Souk menu can be found in Opposers' application for CRONUTS Registration No. 86008577 for classes 9, 16, and 41. A copy of that menu is also attached hereto as Applicants' Exhibit 4.

While Applicants have used fame to embrace, fund and donate to many causes,<sup>75</sup> Opposer is simply attempting to cash in on the fame generated by the Dominique Ansel Cronut pastry and these attempts are transparent as one article states,

“A few days after Ansel started selling his cronuts in New York, Private Social abruptly changed concepts for the second time in its brief life (it opened as Private Social with Tiffany Derry as chef in 2011, earning a four-star review a couple months later). Kaanache’s freewheeling modernist menu was thrown out — cronuts and all — after a one-star review in late April, and now the restaurant features Texas cooking. Kaanache is still in charge of the kitchen. On Saturday, Kaanache tweeted, ‘Today the tasting menu will have the sweet version of Cronuts. Subsequent tweets say they’ve been on her menu ‘for months,’ though they definitely weren’t on the menu when Private Social introduced its new Texas-themed menu.”<sup>76</sup>

The evidence is clear that Opposers’ “cronuts” became a sweet dessert only **after** Applicants first used their Cronut mark in commerce, filed for trademark protection, and became a media darling. The duplicitous, free-riding conduct of the Opposer is exactly what the Board and the Courts have found unsavory and unsweet and cannot stand here.

Opposer Kaanache offers no evidence in support of her claim that the crawfish croquettes were “creative donuts” prior to May 10, 2013. Opposers fail to prove likelihood of confusion or any other Lanham Act-based claim. The true damage in the likelihood of confusion test is to Applicants whereby food critics have made clear that whatever it is that Opposers are serving up, it is not Applicants’ famous Cronut pastry. Opposers’ claims fail to rise above the speculative level and therefore, the Opposition should be dismissed.

**c) Opposers’ Alternative Argument for Reverse Confusion Also Fails**

Opposers argue, in the alternative, reverse confusion, but again, offer no evidence to support this claim. Reverse confusion occurs when the second user becomes better known than the first user.<sup>77</sup> Typical consumer confusion occurs when the second user of a mark “cashes in”

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<sup>75</sup> <http://www.thecronutproject.com/>; <http://www.grubstreet.com/2013/10/cronut-city-harvest.html>.

<sup>76</sup> <http://eatsblog.dallasnews.com/2013/06/letting-the-air-out-of-najat-kaanaches-cronut-scandal.html>.

<sup>77</sup> *Banff v. Fed. Dep’t Stores, Inc.*, 555 F.Supp. 155 (S.D.N.Y. 1982).

on the goodwill generated by the first user of that same mark. Mostly, reverse confusion occurs when a more powerful company uses the mark of a smaller, less powerful senior user.<sup>78</sup>

Applicants, by way of first use and registration date are the senior users. There was no goodwill generated by Opposers nor any evidence that Applicants, who were known for incomparable pastries well before they were aware of Opposers' existence, desired to "cash in" on failed savory crawfish croquettes. Applicants are a small company that garnered media acclaim through honest hard work over many years. Applicant Ansel, in stark contrast to Opposer Kaanache, has worked exclusively as a pastry chef over the course of decades, training with and working for the most distinguished pastry chefs in the world. This experience allows him to provide his customers with the most innovative developments in pastry, desserts, and baked goods. Opposer Kaanache has had no such training nor has she climbed the ranks of the pastry world. Her claim to being the inventor of "cronuts," is simply a ploy to circumvent the necessary training to become a distinguished pastry chef. As Brenner noted, Kaanache's knock-off is a poor imitation of the famous Cronut pastry.<sup>79</sup>

Further, Opposers, as junior users, evidenced by their application dates of June 17, 2013 and July 12, 2013, respectively, are not harmed by Applicants. Opposers have attempted to transform a savory crawfish dish with a name, to which they have no rights, into the famous hybrid croissant-doughnut Cronut pastry while falsely claiming first use in the media.<sup>80</sup> Only after Applicants' Cronut skyrocketed to fame, did Opposer Kaanache attempt to put the same dessert on her menu, claiming it was the "sweet version" of her failed appetizer. However, she placed it

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<sup>78</sup> *Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1003-04 (2d Cir.1983); See also *International News Service v. Associated Press*, 248 U.S. 215, 247, 39 S.Ct. 68, 75, 63 L.Ed. 211 (1918) (Holmes, J., concurring) ("The ordinary case, I say, is palming off the defendant's product as the plaintiff's; but the same evil may follow from the opposite falsehood, — from saying, whether in words or implication, that the plaintiff's product is the defendant's.... [T]he principle that condemns one condemns the other.").

<sup>79</sup> See, *supra*, fn. 26

<sup>80</sup> <http://www.grubstreet.com/2013/06/cronuts-invented-in-dallas.html>.

on the menu in June making *her* the junior user and infringer. Thus, there is no reverse confusion here.

**E. Opposers Fail To State Any Claim Under Section 2(e)(1) of the Lanham Act For Which Relief Can Be Granted**

Opposers contend that Applicants' mark is descriptive. Applicants refer to discussion above regarding the non-descriptive nature and strength of the Cronut trademark and the acquired secondary meaning. Again, Opposers' claims are unintelligible as they argue that "On information and belief, CRONUT as applied to Opposers' "Bakery goods, namely croissant and doughnut hybrid" in their CRONUT application is merely descriptive and does not qualify for registration on the Principle Register..."<sup>81</sup> This appears to be another careless mistype. If, in fact, Opposers mean *Applicants'* "bakery goods, etc.," again Applicants refer to discussion above as to how the Cronut brand has acquired secondary meaning with Applicant Ansel as the creator and the Ansel Bakery as the source of the Cronut pastry. Applicants, are the rightful owners and well-known producers of the Cronut pastry. Thus, having acquired secondary meaning, descriptiveness is not at issue here.

**F. Opposers Fail To State Any Claim Under Section 1(a) of the Lanham Act For Which Relief Can Be Granted**

Opposers contend that Applicants have not used the Cronut pastry and brand in commerce.<sup>82</sup> The Lanham Act defines "use in commerce" as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." Simply put, an applicant cannot make mere token or de minimis use of a mark to reserve its right in commerce. Bona fide commercial transactions that are sporadic, casual or nominal do not qualify as sales "in

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<sup>81</sup> Opposition at 14.

<sup>82</sup> Opposition at 17.

the ordinary course of trade.”<sup>83</sup> Sales made in a good faith effort to develop a business may be sufficient to establish use as a trademark. Thus, the law can be thought of allowing “bona fide use of a mark in the ordinary course of a good faith effort to establish a trade.”<sup>84</sup> It is clear that Applicants have legitimate and bona fide use in commerce that rises above that of mere tokenism. Since the opening of the Ansel Bakery, Applicants have regularly sold the goods in commerce to both intrastate customers and interstate travelers. Applicants’ Cronut pastry is famous world-wide and has enjoyed well-documented and extensive distribution through the site Goldbely.<sup>85</sup> On March 1, 2014, Applicants held a Cronut Pop-Up in Los Angeles that drew a crowd of hundreds.<sup>86</sup> Later that month, Dominique Ansel served Cronut pastries to yet another large crowd of fans at South by Southwest in Austin, Texas.<sup>87</sup>

These events and opportunities are all part of a controlled good-faith effort to develop a business allowable under the Lanham Act. Cronut, like most brands, is engaged in natural expansion conducive to continued success. The Cronut brand is known globally and Applicants have proof of the Cronut brand’s wide-spread popularity from photos submitted by fans throughout the world.<sup>88</sup> To continue its natural course of expansion, the Cronut brand must be protected as it serves interstate travelers and is in the process of achieving continued national distribution.

Conversely, Opposers fail to show, a) any evidence of “cronuts” which would qualify for inclusion in Class 30; b) any evidence of ownership or actual creation of a mark which would

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<sup>83</sup> See *Procter & Gamble Co. v. Johnson & Johnson, Inc.*, 485 F.Supp. 1185 (S.D.N.Y. 1979), *aff’d* without opinion 636 F.2d 1203 (2d Cir. 1980) (shipment of 50 cases a year are nominal and do not represent placement on the market in a meaningful way or a bona fide attempt to establish a trade or commercial use).

<sup>84</sup> *Era Corp. v. Electronic Realty Associates, Inc.*, 211 U.S.P.Q. 734, 745 (T.T.A.B. 1981), cited in *Cake Divas v. Charmaine Jones*, Opposition No. 91177301 (T.T.A.B. Feb. 23, 2010).

<sup>85</sup> [http://www.huffingtonpost.com/2013/12/13/cronut-shipping\\_n\\_4438918.html](http://www.huffingtonpost.com/2013/12/13/cronut-shipping_n_4438918.html).

<sup>86</sup> [http://la.racked.com/archives/2014/02/26/a\\_cronuts\\_pop](http://la.racked.com/archives/2014/02/26/a_cronuts_pop).

<sup>87</sup> <http://www.fastcocreate.com/3027401/cronut-inventor-says-his-mind-melting-sxsw-milk-and-cookie-shots-are-coming-to-ny>.

<sup>88</sup> See Applicants’ Exhibit 5.



qualify for use in commerce prior to Applicants' date of first use; and c) any evidence of "creative donuts" prior to Applicants' date of first use of May 10, 2013. Thus, Applicants, and not Opposers, have used the mark in commerce.

**G. Opposers Fail To State Any Claim Under Section 29 of the Lanham Act For Which Relief Can Be Granted**

Opposers contend that Applicants are misusing the registration symbol "in an attempt to deceive the public into believing their CRONUT mark is registered and also are wrongfully asserting CRONUT is registered in their enforcement efforts." Applicants applied for and were granted a certificate of registration and all assertions and enforcement efforts are proper as of January 14, 2014.<sup>89</sup> Applicants also own registered international trademarks for Cronut in the United Kingdom, Monaco, Hong Kong, Switzerland, and Australia.

**H. Opposers Fail To State Any Claim for Applicants' Fraud Upon The United States Patent and Trademark Office For Which Relief Can Be Granted**

Opposers' shameless conduct continues as they put forth the outrageous allegation that Applicants' counsel committed fraud upon the USPTO without any evidence in support of such a claim. To establish fraud, Opposers must plead and prove with particularity:

1. The applicant/registrant made a false representation to the USPTO;
2. The false representation is material to the registrability of the mark;
3. The applicant/registrant had knowledge of the falsity of the representation; and
4. The applicant/registrant made the representation with intent to deceive the USPTO.<sup>90</sup>

Since May 2013, Applicants have asserted that the Cronut brand applies to all goods sold at the bakery.<sup>91</sup> The full list of goods applied for under Class 30 by the Applicant are all available and sold at the bakery.<sup>92</sup> Thus, no fraud was committed upon the USPTO by Applicants' counsel.

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<sup>89</sup> See Applicants' Exhibit 1 and Exhibit 3; Applicants also have international trademark in the United Kingdom, Australia, Hong Kong, Monaco and Switzerland.

<sup>90</sup> *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009) (the Federal Circuit has set forth a new standard by which to weigh a fraud claim, explaining that a trademark is obtained fraudulently only if the applicant or registrant knowingly makes a false material representation with the intent to deceive the USPTO.)

#### IV. Conclusion

For the foregoing reasons, Applicants' Motion to Dismiss should be granted and the Notice of Opposition denied.

Dated: May 15, 2014

By: Candice S. Cook

Candice S. Cook, Attorney for Applicants

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<sup>91</sup> <http://www.foxnews.com/leisure/2013/07/03/cronut-craze-has-reached-new-heights>.

<sup>92</sup> See Applicants' Exhibit 6.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of the MOTION TO DISMISS was served on Counsel for Opposer by certified mail and first class mail at the address below:

Robert B.G. Horowitz  
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Dated: MAY 18, 2014

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# **CERTIFICATE OF ELECTRONIC FILING**

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 18 of May, 2014.

Dated: May 18, 2014

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# **EXHIBIT 1**

The chart below demonstrates that the evidence submitted by Opposers in support of their Notice of Opposition goes counter to their claims and instead confirms that Dominique Ansel invented the Cronut. Specifically, the chart identifies specific quotes from the Opposers' evidence, virtually all of which expressly states that Dominique Ansel created the Cronut. The chart also includes quotes that show that the mark "Cronut" is synonymous with Dominique Ansel as well as public knowledge that he has sought and protected the trademark for the Cronut brand. Due to the submission format of the Opposers' Notice of Opposition, individual references for the evidence attached to the opposition are not available. Accordingly, the evidence will be referenced as follows: (1) source of the document; (2) title of the article, blog, video or web page; (3) web address; and (4) date of publication.

<u>Source</u>	<u>Title</u>	<u>Web Address</u>	<u>Date</u>	<u>Quote(s)</u>
Wikipedia	Cronut	en.wikipedia.org/wiki/Cronut	9/27/2013	<p>"The Cronut is a croissant-doughnut pastry developed by chef Dominique Ansel for Dominique Ansel Bakery in New York City. In May 2013, the bakery trademarked the name. Imitation versions of Ansel's croissant-doughnut hybrid recipe have sprung up in Saint Louis, Los Angeles, Jacksonville, Minneapolis, and Sydney, Australia. A similar make-at-home recipe has also been developed. These similar versions largely go under different names since the mark Cronut has pending trademark applications filed with the USPTO and internationally. The bakery's Facebook site states that Cronut is not a generic term to describe all croissant-doughnut hybrids, but a specific pastry associated with the bakery. A Boston Globe article describes the Dominique Ansel Bakery croissant-doughnut hybrid as food portmanteau."</p> <p>"The Dominique Ansel Bakery's website states that though the item is best described as "Half Croissant, Half Doughnut" it is not made by simply frying croissant dough, but a type of laminated dough using a proprietary recipe that took the chef two months and 10 recipes to make."</p> <p>"Ansel's Cronut has been featured on Late Night with Jimmy Fallon, The Today Show, Good Morning America and Piers Morgan Live on CNN with host Anthony Bourdain. Dominique Ansel's Cronut has also been seen with celebrities Heidi Klum, Hugh Jackman, Joel McHale and Emma Roberts."</p>

<u>Source</u>	<u>Title</u>	<u>Web Address</u>	<u>Date</u>	<u>Quote(s)</u>
				<p>"In September of 2013, Victoria Beckham was rumored to have been conned into purchasing a fake Cronut. She was called out when it disclosed that Dominique Ansel's real Cronuts were offered exclusively to the fashion brand Opening Ceremony due to a prior arrangement between Chef Ansel and the fashion brand."</p> <p>"In July 2013, Dominique Ansel Bakery launched a series of charitable campaigns with their Cronut product to benefit the Food Bank for New York City. The campaign The Cronut Project, sponsored by Dominique Ansel and three interns at BBH benefitted Food Bank for New York City by raising over \$6K in 6 days with only 12 Cronuts."</p> <p>"In September 2013, Dominique Ansel Bakery partnered with Shake Shack to offer Cronut Hole Concretes, featuring the first ever Cronut Holes from Dominique Ansel Bakery and brown butter caramel custard. Hundreds of people lined up as early as 4am at a chance to purchase one of the 1000 Cronut Hole Concretes. All proceeds were donated to the NYPD Widows and Children Fund and Madison Square Park Conservatory. More than \$5,300 was raised."</p> <p>"The Swiss retailer Migros started selling cronuts in August 2013. To prevent this, Ansel announced that he intended to register 'cronut' as a Swiss trademark."</p>
Grub Street	Introducing the Cronut, a Doughnut-Croissant Hybrid That May Very Well Change Your Life	<a href="http://www.grubstreet.com/2013/05/dominique-ansel-cronut.html">www.grubstreet.com/2013/05/dominique-ansel-cronut.html</a>	5/9/2013	<p>"Starting tomorrow, this round, glazed thing you see before you will be added to the permanent collection at Dominique Ansel Bakery. Because it's part croissant and part doughnut, the pastry chef is, appropriately, calling it a cronut."</p> <p>"Ansel says it took around 10 recipes and adjustments to multiple variables of time and temperature before he found a special trick to sheeing the dough, then learning to fry it in grapeseed oil at one specific (and someone secret) temperature."</p>

<u>Source</u>	<u>Title</u>	<u>Web Address</u>	<u>Date</u>	<u>Quote(s)</u>
				<p>"Ansel's ongoing work with religious and his reinvention of the fraiser already had us convinced that the pastry chef routinely dares to dream at his Soho shop and is never content to rest on his macarons (though they are also very good), but this is just sort of nuts. It's a bold step forward for pastry."</p> <p>"Cronuts are \$5.00 apiece and go on sale tomorrow at the bakery, just in time for Mother's Day."</p>
CBS St. Louis	The 'Cronut' ...Er, That's the 'Doughssant' ...Has Arrived In St. Louis	stlouis.cbslocal.com/2013/07/08/the-cronut-er-thats-the-doughssant-has-arrived-in-st-louis/	7/8/2013	<p>"[T]he 'cronut' inventor has trademarked the name so Becker held a contest on his facebook page to let customers vote on a new name, with the winner being 'doughssant.'"</p>
First Coast News	'Cronut' craze has made it to Jacksonville	www.firstcoastnews.com/topstories/article/318217/483/Cronut-craze-has-made-it-to-Jacksonville?odysey=tab%7Ctopnews%7Cbc%7Clarge	6/28/2013	<p>"A croissant-doughnut mix originally from New York was created by Dominique Ansel a few years ago. And now people on the First Coast are going nuts for the 'cronut.'"</p>
Huffington Post	Cronut In Canada: Fever Hits Vancouver as 'Frissant' Unveiled	www.huffingtonpost.ca/2013/06/27/cronut-in-canada-vancouver-n_3511850.html	6/27/2013	<p>"You've heard of the cronut, right? The hybrid donut-croissant invented — and trademarked — by New York pastry chef Dominique Ansel has sparked copycats around the world since its arrival in the baked goods category back in March."</p>
Khon 2	Cronut craze comes to Hawaii	khon2.com/2013/09/25/cronut-craze-comes-to-hawaii/	9/25/2013	<p>"Originally created by famed pastry chef Dominique Ansel in SoHo, New York just over four months ago, the Cronut has sparked a global food fad with Cronut copycats as far as Brazil, London, and in Hawaii."</p>



<u>Source</u>	<u>Title</u>	<u>Web Address</u>	<u>Date</u>	<u>Quote(s)</u>
Sorted	How To Make Cronuts	sortedfood.com/#/cronuts/		"Cronuts are a mix between a croissant and a doughnut/donut, and are the most gorgeous sweet treats that have been taking over Manhattan and London for the last couple of months! Dominique Ansel may have started them, but we've shared with you a recipe courtesy of Edd Kimber to bring them to you guys!"
Daily Mail	Make your own Cronuts: DIY manual allows food-craze fans to avoid the lines by making their own sugary treats at home	www.dailymail.co.uk/news/article-2389350/Cronut-recipe-Avoid-lines-stay-home-Cronuts-masses.html	8/11/2013	"Invented by baker Dominique Ansel, cronut fans have taken over SoHo standing on line for hours" "First sold by the Dominique Ansel Bakery in New York, the croissant-doughnut that took over the city's SoHo neighborhood earlier this year can now be made from the comfort of your own kitchen."
Youtube	How to make Cronuts	www.youtube.com/watch?v=RgtdGbpokpA	8/11/2013	"Cronuts are a mix between a croissant and a doughnut/donut, and are the most gorgeous sweet treats that have been taking over Manhattan and London over the last couple of months! Dominique Ansel may have started them, but we've shared with you a recipe courtesy of Edd Kimber to bring them to you guys!"
Dominique Ansel Bakery	Dominique Ansel Bakery	dominiquansel.com		"The Cronut™, Half croissant, Half Doughnut. The signature of pastry by Dominique Ansel."

# **EXHIBIT 2**

# United States of America

United States Patent and Trademark Office

## Cronut

**Reg. No. 4,465,439**

**Registered Jan. 14, 2014**

**Int. Cl.: 30**

**TRADEMARK**

**PRINCIPAL REGISTER**

INTERNATIONAL PASTRY CONCEPTS LLC (NEW YORK LIMITED LIABILITY COMPANY)  
DOMINIQUE ANSEL  
189 SPRING STREET  
NEW YORK, NY 10012 AND

DOMINIQUE ANSEL (FRANCE INDIVIDUAL)  
DOMINIQUE ANSEL  
189 SPRING STREET  
NEW YORK, NY 10012

FOR: BAKERY DESSERTS; BAKERY GOODS; BAKERY GOODS AND DESSERT ITEMS, NAMELY, CHEESECAKES FOR RETAIL AND WHOLESALE DISTRIBUTION AND CONSUMPTION ON OR OFF THE PREMISES; BAKERY GOODS, NAMELY, CROISSANT AND DOUGHNUT HYBRID; BAKERY PRODUCTS; BAKERY PRODUCTS, NAMELY, SWEET BAKERY GOODS; BEVERAGES MADE OF COFFEE; BEVERAGES MADE OF TEA; BEVERAGES WITH A CHOCOLATE BASE; BEVERAGES WITH A COFFEE BASE; BISCUITS; BISCUITS AND BREAD; BISCUITS, TARTS, CAKES MADE WITH CEREALS; BREAD AND BUNS; BREAD AND PASTRY; BREAD DOUGHS; BREAD MIXES; BREAD ROLLS; BREAD STICKS; BRIOCHES; CAKE DOUGHS; CAKE ICING; CAKE MIXES; CAKES; CHOCOLATE FOR CONFECTIONERY AND BREAD; COCOA-BASED BEVERAGES; COCOA-BASED INGREDIENT IN CONFECTIONERY PRODUCTS; COFFEE BASED BEVERAGES; COFFEE BEVERAGES WITH MILK; COFFEE-BASED BEVERAGES; COFFEE-BASED ICED BEVERAGES; CONFECTIONERIES, NAMELY, SNACK FOODS, NAMELY, CHOCOLATE; CONFECTIONERY CHIPS FOR BAKING; COOKIE DOUGH; COOKIE MIXES; COOKIES; CROISSANTS; DOUGHNUTS; EDIBLE CAKE DECORATIONS; EDIBLE DECORATIONS FOR CAKES; EDIBLE FLOUR; FOOD PACKAGE COMBINATIONS CONSISTING PRIMARILY OF BREAD, CRACKERS AND/OR COOKIES; INSTANT DOUGHNUT MIXES; MACAROONS; MADELEINES; MIXES FOR BAKERY GOODS; MUFFIN MIXES; MUFFINS; PASTRIES; PASTRY DOUGH; PASTRY MIXES; PREPARED COCOA AND COCOA-BASED BEVERAGES; PREPARED COFFEE AND COFFEE-BASED BEVERAGES; SCONES, IN CLASS 30 (U.S. CL. 46).



*Nichelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office

FIRST USE 5-10-2013; IN COMMERCE 5-10-2013.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

# **EXHIBIT 3**



Australian Government

IP Australia

# CERTIFICATE OF REGISTRATION OF TRADE MARK

No. 1576675

I, **Fatima Beattie, Registrar of Trade Marks** hereby certify -

that the trade mark represented on this certificate was filed as Trade Mark No. 1576675 on **26 August 2013**. It is due for renewal on **26 August 2023** and **Dominique Ansel** of **189 Spring St New York 10012-3689 NY UNITED STATES OF AMERICA** and **International Pastry Concepts LLC** of **189 Spring St New York 10012-3689 NY UNITED STATES OF AMERICA** have been entered in the Register of Trade Marks as joint owners of the trade mark.

The trade mark is registered in the following class/es: **30**

## CRONUT

The goods and/or services for which the trade mark is registered, plus any endorsement, additional owners or other information relating to the registration, are listed on the attached pages.

*Given under my hand and the seal of the Trade  
Marks Office on 21 February 2014*



**Fatima Beattie**  
**REGISTRAR OF TRADE MARKS**


TRADE MARKS ACT 1995



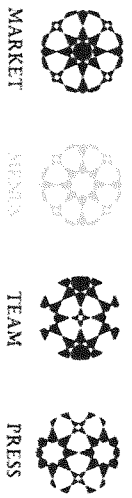
ARRANGEMENT ET PROTOCOLE DE MADRID  
DÉCISION FINALE CONCERNANT LA SITUATION DE LA MARQUE

– DÉCLARATION D'OCTROI DE LA PROTECTION –

Règle 18<sup>ter</sup>.1)

I.	Office qui envoie la déclaration : Division de la Propriété Intellectuelle de Monaco 9 rue du Gabian 98000 Monaco
II.	Numéro de l'enregistrement international : 1180079
III.	Nom du titulaire (ou autre indication permettant de confirmer l'identité de l'enregistrement international) : International Pastry Concepts LLC Dominique Ansel, 189 Spring Street (US)
IV.	La protection est accordée à la marque qui fait l'objet de cet enregistrement international pour tous les produits et/ou tous les services demandés.
V.	Signature ou sceau officiel de l'Office qui envoie la déclaration : 
VI.	Date : 04/02/2014

# **EXHIBIT 4**



Starters & Salads | Soups & Sides | Grilled Items | Bread | Lunch | Dinner & Desserts | Wine

“STARTERS TO NIBBLE”

Crawfish Cronuts™ - 8

Croquette donuts, cilantro, saffron essence ~ charoula mousse

Biccya Teal - 8 <sup>oo</sup>

Baked phyllo pie with chicken, orange blossom, cinnamon, honey and almonds

Harira - 7

Tomato soup with green lentils, lemon zest, cilantro-oil, dates and a crusty crouton with Harissa tapenade

MINI MEZZE CARRITO

Souk Platter - 15

Mezza Carrito - 24

<sup>oo</sup> Atlas Olives - 6

Marinated olives, confit garlic & fresh cilantro

Mu'akouda - 8



# **EXHIBIT 5**



11:45 PM - 24 Apr 2014

Flag media



**Dominique Ansel** @DominiqueAnsel · Apr 25

@teresawliao I hope it's still okay! Short shelf life! Happy beef noodle soup eating!

Details

↩ Reply ↻ Retweet ★ Favorite ... More



**Teresa 廖** @teresawliao · Apr 25

@DominiqueAnsel my friend enjoyed it, but would like to try a fresh one when she's in NYC!

Details

↩ Reply ↻ Retweet ★ Favorite ... More

# **EXHIBIT 6**

REDACTED FOR CONFIDENTIALITY

**DOMINIQUE ANSEL  
BAKERY**

189 SPRING STREET,  
NEW YORK, NY 10012  
212-219-2773

Daily Closing (Detail)

May 10, 2013

STID: ALL

ADMIN

Printed Date :

5/14/2014 12:20 PM

Total # of Trans : 492

Avg Sales :

Void :

Category	Sales Qty	Rtn. Qty	Total
BREAKFAST	50	0	
CAKES & TARTS	105	0	
CANNELE	4	0	
COFFEE (COLD)	128	0	
COFFEE (HOT)	196	-1	
COOKIES	93	0	
ICE CREAM/SORBET	15	0	
LARGE CAKES	1	0	
MACARONS	33	0	
MACARONS PKG	21	0	
MADE-TO-ORDER	17	-1	
MINI ME'S	1	0	
MISC	7	0	
OTHER COLD DRINKS	54	0	
OTHER HOT DRINKS	14	0	
SALADS	10	0	
SANDWICHES	33	-2	
SEASONAL ITEMS	1	0	
SOUP	3	0	
Special Coffee	1	0	
TEA (COLD)	30	0	
TEA (HOT)	9	0	
VIENNOISERIE	281	0	

Gross Sales :

Refund :

Tax :

Net Sales :